

1/4/02

**THIS DISPOSITION  
IS NOT CITABLE AS PRECEDENT  
OF THE T.T.A.B.**

Hearing:  
November 6, 2001

Paper No. 21  
PTH

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Trademark Trial and Appeal Board**  
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IWC International Watch Co. AG  
v.  
Finetime, Inc.  
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Opposition No. 115,330  
to application Serial No. 75/517,419  
filed on July 8, 1998  
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Donald L. Dennison of Dennison, Scheiner, Schultz &  
Wakeman for IWC International Watch Co. AG.

Peter S. Herrick for Finetime Inc.  
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Before Simms, Hairston and Bottorff, Administrative  
Trademark Judges.

Opinion by Hairston, Administrative Trademark Judge:

An application has been filed by Finetime, Inc. to  
register the mark DA VANCI for "watches, clocks, and  
parts."<sup>1</sup>

Registration has been opposed by IWC International  
Watch Co. AG on the ground of likelihood of confusion  
between applicant's mark and opposer's previously used

and registered mark DA VINCI for "watches and parts therefor."<sup>2</sup>

Applicant, in its answer, denied the salient allegations of the notice of opposition.

The record consists of the pleadings; the file of the involved application; and the testimony deposition (with exhibits) of opposer's vice-president for North America operations, Marc Bernhardt. Applicant did not take testimony or otherwise properly offer any evidence on its behalf.<sup>3</sup>

Both parties filed briefs of the case, and a hearing was held.

The record shows that opposer, which was founded in 1868, is a manufacturer of high quality and expensive timepieces. The timepieces range in price from \$2,000 to

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<sup>1</sup> Serial No. 75/517,419 filed July 8, 1998, alleging dates of first use of July 1, 1992.

<sup>2</sup> Registration No. 1,994,273 issued August 20, 1996.

<sup>3</sup> We note that the Board, in an order issued May 30, 2001, inter alia, granted opposer's motion to strike applicant's notice of reliance on discovery materials. The notice of reliance was untimely filed and the Board stated that the materials would be given no consideration. Applicant resubmitted these materials with its brief on the case. However, a party may not rely on materials submitted with its brief on the case unless those materials have been properly made of record during its testimony period. Because the materials were not properly made of record during applicant's testimony period, they do not form part of the record in this case and we have not considered the materials in reaching our decision herein.

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\$350,000 and are marketed worldwide. Opposer markets  
four

lines of watches, one being DA VINCI. The DA VINCI line of watches was introduced in the United States around 1986, and opposer has continuously marketed DA VINCI watches in the United States since that date. The retail price of opposer's DA VINCI watches runs from \$12,500 to \$83,000. Opposer primarily advertises in the print media and opposer's witness, Mr. Bernhardt estimated that opposer would spend approximately \$250,000 to \$300,000 advertising its DA VINCI watches in 2000.

We have little information about applicant inasmuch as applicant failed to take testimony or properly submit any other evidence in this case.

Priority of use is not in issue inasmuch as opposer introduced a copy of its pleaded registration for the DA VINCI mark through the testimony of Mr. Bernhardt and he testified that the registration is subsisting and owned by opposer. See *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). The only issue is whether applicant's use of DA VANCI for watches, clocks and parts would be likely to cause confusion with opposer's mark DA VINCI for watches and parts.

Upon consideration of the pertinent factors set forth in *In re E. I. Du Pont de Nemours & Co.*, 476 F.2d

1357, 177 USPQ 563, 567 (CCPA 1973), for determining whether a likelihood of confusion exists, we agree with opposer that confusion as to source or sponsorship is likely to occur.

We turn first to a consideration of the parties' respective goods. Applicant, in its brief on the case, argues that the parties' watches are in "very different price ranges, appeal to consumers of vastly dissimilar sophistication, and are sold in markedly different channels of trade." (Brief, p. 3) However, it is well settled that the issue of likelihood of confusion in a proceeding such as this must be determined on the basis of the identification of goods set forth in the plaintiff's registration vis-à-vis the identification of goods set forth in the defendant's involved application, regardless of what the evidence may show as to the specific nature of the parties' goods. See *Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ 2d 1813 (Fed. Cir. 1987). There being no limitations in the identification of goods in either applicant's application or opposer's registration, it must be presumed that both parties' goods would encompass all price ranges, would travel in all the normal channels of trade and be sold to all the usual purchasers for goods

of this nature. Thus, for the purposes of determining likelihood of confusion, not only are the goods of the parties identical or closely related, but also it must be assumed that these goods would be marketed through the same channels of trade to the same purchasers.

With respect to the marks, there are obvious similarities between applicant's mark DA VANCEI and opposer's mark DA VINCI. The only difference in the marks is in the second word where the letter "A" appears in applicant's mark instead of the letter "I" which appears in registrant's mark. Consumers may not even notice this difference in the marks as they appear on the face or back of the parties' watches because the marks are small. In short, when considered in their entirety, we find that applicant's mark DA VANCEI is substantially similar in sound, appearance and commercial impression to registrant's mark DA VINCI.

Two other matters raised by applicant in its brief on the case require comment. First, applicant essentially argues that marks consisting of the term DA VINCI are weak, and that applicant's mark is thus entitled to a limited scope of protection. In support of this argument, applicant requests that the Board take judicial notice of certain third-party registrations for

the mark DA VINCI. However, the Board does not take judicial notice of registrations which reside in the Patent and Trademark Office. Again, such registrations must be properly made of record during a party's testimony period. Moreover, even if applicant had made the registrations of record, we should point out that third-party registrations, in and of themselves, are entitled to little weight in evaluating whether there is a likelihood of confusion. See, e.g., *AMF Inc. v. American Leisure Products, Inc.*, 474 F.2d 1403, 177 USPQ 268, 269 (CCPA 1973), and *In re Hub Distributing, Inc.*, 218 USPQ 284, 285-86 (TTAB 1983). This is because third-party registrations are not evidence of what happens in the marketplace.

Second, with respect to applicant's contention that there is no evidence of any known instances of actual confusion, we have no evidence concerning the extent of applicant's use of its mark, and thus we are unable to determine whether there has been any opportunity for confusion to occur. Moreover, evidence of confusion is difficult to obtain and, in any event, the test is likelihood of confusion.

In sum, we conclude that confusion as to source or sponsorship is likely to result from the contemporaneous

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use of opposer's mark DA VINCI and applicant's substantially similar mark DA VANCI for identical and closely related goods.

**Decision:** The opposition is sustained and registration to applicant is refused.